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IN THE

# SUPREME COURT OF THE UNITED STATES

October Term, 1943.

No. 301.

RADIANT POINT PEN CORPORATION,
*Petitioner,*

*v.*

C. HOWARD HUNT PEN COMPANY,
*Respondent.*

## BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

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*To the Honorable the Chief Justice and Associate Justices of the Supreme Court of the United States:*

### FOREWORD.

This is an ordinary patent case.

The patents involved have never been before any Court other than the Courts of the Second Circuit in this case.

Obviously, there is thus no conflict of decisions as between different Circuits as to the validity of the patents or as to infringement thereof.

Nor is there any conflict of decisions internal of the Second Circuit. Both the District Court and the Circuit Court of Appeals concurred in holding the two claims of Patent No. 2,001,726 to be valid and infringed, and claims 1 and 2 of Patent No. 2,121,541 to be valid and claim 1 infringed. (Petitions for Re-hearing were presented to both the District Court and the Court of Appeals, and were denied.)

Examination of the "Reasons for Allowance of the Writ" makes it clear that the sole ground upon which the Petition is founded is the assertion that the decision herein is based on principles in conflict with principles laid down by this and other Courts. This is not so, as will be pointed out hereinafter.

In all other respects, the petition amounts to nothing more than a request for hearing by this Court to review the evidence upon which the Courts of the Second Circuit concurred in reaching their conclusions as to the validity and construction of the patents and infringement thereof by the Petitioner. This is no basis for the granting of a Writ. *General Talking Pictures Corp. vs. Western Electric Co.*, 304 U. S. 177-178.

The case thus plainly falls in the class of *Keller et al. vs. Adams-Campbell Co.*, 264 U. S. 314, and *Layne & Bowler Corporation v. Western Well Works*, 261 U. S. 388, 393, in which latter case the Court stated:

> "it is very important that we be consistent in not granting the writ of certiorari except in cases involving principles the settlement of which is of importance to the public as distinguished from that of the parties, and in cases where there is a real and embarrassing conflict of opinion and authority between the Circuit Courts of Appeal."

The present case falls in neither category.

PETITIONER'S REASONS FOR "ALLOWANCE OF WRIT".

On page 7 petitioner asserts that there is a "conflict between the decisions herein, and decisions by other Circuit Courts of Appeal, and the decisions of this Court".

An examination of the text, however, makes it apparent that what is meant is that the Court of Appeals, in sustaining the patents here in suit, sets up principles which run counter to principles laid down in decisions by other Courts of Appeal and this Court.

As to the first Henwood Patent No. 2,001,726, Petitioner argues that claim 2, which is for an *article* of manufacture, for its novelty or patentability "relies on the method of manufacture", i. e., the slitting of the point *after* the tabs or wings are bent down; and that, therefore, the Court in sustaining this article claim runs counter to the principle that a claim for an article of manufacture must recite the features of construction "constituting novelty" over the prior art, and that "the method by which the article is produced is not one of such features", as held in *Westinghouse Electric & Mfg. Co. v. Quackenbush*, 53 F. (2d) 632, 634.

In the first place, to support any such contention of conflict of decision on this score, Petitioner must establish that the Court of Appeals in this case laid down an opposite principle, namely, that it had laid down the principle that an article claim is patentable where the sole novelty resides in the method by which the article is produced.

Nowhere does the Circuit Court of Appeals say that the novelty of claim 2 depends upon the method by which the article is produced, but to the contrary, that Court points out that the novelty resides in features of construction. Thus that Court said (Rec. p. 276), that there is "spacing metal" between the ears at least equal to the width of the forming tool, which spacing metal (the "central part" of the claim) separates the tabs at the "base or

upper sides". As to this, the Court states (same page), "Both the claims in suit are tied to this new feature which was not present in the prior art" (emphasis ours, unless otherwise indicated).

More specifically, the Court of Appeals in distinguishing the patent in suit from the prior patent to Hawkes stated (same page)—

> "Hawkes disclosed nothing about *spacing metal* left in its original plane between any wings or tabs when they were bent down."

and in distinguishing from the prior British patent to Petit, stated (same page):

> "the British patent did not disclose *this* feature and so did not anticipate."

Thus it is clear that the Court of Appeals predicated patentability of claim 2 of the patent flatly upon this new feature of construction, namely, the spacing metal or "central part" between the base or upper sides of the ears and did not predicate patentability of this article claim upon the method by which the article is produced.

In addition, an examination of the claim will show that no such method step of slitting after bending of the ears, is recited therein. There is no reference whatever in the claim to the performing of the slitting operation after bending down of the tabs. To the contrary, the claim positively calls for "a slit", making no mention of when or how it is made. The positively recited features of construction, including the spacing metal between the tips or ears, i. e., the "central part" called for by the claim, constitute the novelty.

Hence the Court of Appeals, neither directly nor indirectly, has laid down a principle conflicting with the principle laid down in the *Westinghouse Electric & Mfg. Co. v. Quackenbush* case (*supra*) upon which Petitioner relies.

Moreover, even if Petitioner's contention as to claim 2 be assumed to be correct, this would put Petitioner in no better case on his Petition; because claim 1 which was held valid and infringed by both lower Courts, is directed to the very method of slitting the pen point *after* the ears have been bent down and there is no contention of conflict of decisions with respect to claim 1 of this Henwood patent.

Under Petitioner's argument, claim 2 in effect becomes claim 1, but since Petitioner has been held to infringe claim 1, what difference does it make whether his contention as to claim 2 is correct or not?

The second ground of conflict of decision advanced by Petitioner with respect to this Henwood Patent No. 2,001,726 is that in sustaining it the Court of Appeals was in conflict with the principle laid down in decisions by other Courts of Appeal which condemn "double patenting".

Respondent owns the earlier issued Hawkes Patent No. 1,365,318, and also this later issued Henwood patent. Petitioner alleges that both patents monopolize the same essential idea and that, therefore, the Henwood patent is a double patenting of what was covered in the Hawkes patent, and an extension of the monopoly thereof.

That very issue was presented before the Court of Appeals, as will be clear on inspection of the opinion (Rec. p. 275), and was decided adversely to Petitioner.

There is plainly, therefore, no conflict with the decisions referred to on the matter of double patenting. The lower Courts held simply that there was no double patenting and there could, therefore, be no conflict with decisions condemning it.

More specifically, and as previously pointed out, page 4 hereof, the Court of Appeals held that both the claims of this Henwood patent "are tied to this new feature", i. e., the spacing metal between the wings or tabs lying in the original plane of the blank, and that "Hawkes

disclosed nothing about spacing metal left in its original plane between any wings or tabs". It is obvious that since the claims of the Henwood patent are directed and limited to a feature not disclosed in the Hawkes patent, there can be no question of double patenting. Thus, neither claim reads upon Hawkes; nor does Hawkes have a disclosure which would have supported the claims. Moreover, as pointed out by the Court of Appeals in its opinion, page 275, and as admitted by Petitioner's own expert witness, Hammer, Rec. p. 230, the Hawkes patent is directed to a different type of pen point, and to a different method of manufacture. As the Court of Appeals stated,

> "The object of this (Hawkes) invention was not to produce a *new* kind of pen point but to save time and material in making the *known* types."

It will be apparent from the foregoing that Petitioner is asking nothing more than that this Court review the evidence to determine first, that claim 2 of the patent depends upon the method for its validity, and, second, that both claims of the patent represent a double patenting of the monopoly supposed to have been granted to Hawkes.

Petitioner presents absolutely no reason why this should be done in this case nor why this is not the "ordinary patent case, with the usual issues" (*Keller et al. v. Adams-Campbell*, 264 U. S. 314, 319) wherein this Court stated that it would "not bring (the case) here by certiorari unless it be necessary to reconcile decisions of Circuit Courts of Appeal on the same patent".

As to the second Henwood Patent No. 2,121,541, Petitioner asserts that what is claimed therein had been publicly used by the plaintiff for more than two years before the application for the patent was filed. Hence Petitioner argues that, in sustaining this patent, the Court has run counter to the decisions of other Courts that a pat-

ent is invalid when its subject matter has been in public use for more than two years.

The same argument was fully presented before the Court of Appeals and was there fully answered by Respondent. The Court of Appeals in sustaining the patent, ruled adversely to the Petitioner.

Thus, again, there is no conflict with decisions of other Courts, and it becomes clear that all that Petitioner is asking is for a review of the evidence upon which the Court of Appeals reached its conclusions.

Lastly, the Petitioner contends that the decisions herein give Respondents a monopoly of the manufacture of cheap pen points for fountain pens, referring to page 45 of the record. The decisions in this case do not go beyond sustaining the patents in suit and do not extend Petitioner's monopoly beyond that lawfully granted in the patents themselves. Moreover, an examination of the testimony referred to shows only that Respondent's sales of the patented pen points averaged fourteen and a half million per year. The record shows that the patented pen point in large part supplanted pen points for cheap fountain pens theretofore used, but this was due to the intrinsic merit of the point and had occurred long prior to any decision in this case. As the Circuit Court of Appeals held (Rec. p. 274):

> "Without an appreciable amount of advertising and apparently because of its own inherent superiority, the pen of the patent has been manufactured and sold in very large quantities."

## Conclusion.

The reasons given by Petitioner for granting the writ are insubstantial and it is clear that all Petitioner seeks is another hearing. As was held in *Magnum Import Co. v. De Spoturno Coty*, 262 U. S. 159, 163,

"The jurisdiction was not conferred upon this Court merely to give the defeated party in the Circuit Court of Appeals another hearing."

The petition for writ of certiorari should be denied.

Respectfully submitted.

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